

REMARKS

INTRODUCTORY STATEMENT:

This application was filed on December 29, 2000 with 80 claims. The Restriction Requirement at issue attempts to divide the claims into six separate groups. Applicants submit that the pending claims should *not* be divided into more than *three* separate claim groups. Claims 1-58 should be kept together as devices comprising a substrate and an integrated indicator. Claims 59-62 should be kept together because they all recite the attachment of molecular moieties to the substrate of the device of claim 56. Claims 63-80 should be kept together because they set forth the assaying of a sample using the device of claim 1.

Turning to the procedures governing restriction practice, section 803 of the MPEP provides that criteria for a proper restriction requirement are:

- (A) Inventions that are independent or distinct when claimed; and
- (B) A serious burden on the Examiner.

CLAIMS DIRECTED TO A DEVICE COMPRISING A SUBSTRATE AND AN INTEGRATED INDICATOR

The Examiner argues that Groups I and II are generally unrelated and independent inventions. In support, the Examiner states that they have different required components and that the different components have different modes of operation and different functions. Specifically, the Examiner contends that the integrated indicator common to the claims of Group I is not required by the claims of Group II and that the plurality of different integrated indicators common to the claims of Group II is not required by the claims of Group I.

Applicants respectfully disagree because *a plurality of integrated indicators necessarily includes one integrated indicator*. In addition, the claims of the two groups have substantial overlapping features. Common features include a substrate having a surface for attachment to molecular probes and at least one integrated indicator. Although the Examiner has recognized that the claims of Group II differ from the claims of Group I in that the claims of Group II contain an additional indicator, an indicator by itself is clearly unpatentable. Thus, the claims of Group II are substantially indistinct from the claims of Group I for searching and examination purposes. In addition, art pertaining to a device comprising a substrate and a plurality of

indicators will necessarily be pertinent to a device comprising a substrate and an indicator, and searching for art pertinent to both types of devices will pose no serious burden on the Examiner. Accordingly, the claims of Groups I and II should be searched and examined together.

CLAIMS RECITING THE ATTACHMENT OF MOLECULAR MOIETIES TO A SUBSTRATE SURFACE

The Examiner also argues that Groups III and IV are generally unrelated and independent inventions. Stating that they have different required components and that the different components have different modes of operation and different functions, the Examiner specifically contends the claims of Groups III and IV are related as a process and an apparatus for carrying out the process and that the apparatus as claimed can be used to practice another and materially different process, such as an ink-jet print method to prepare a coated substrate. As another example, the Examiner contends that the apparatus may be used to carry out oligonucleotide synthesis.

In response, Applicants point out that all claims of Groups III and IV recite the attachment of molecular moieties to the substrate surface of a device comprising a substrate having an integrated indicator. Clearly, any apparatus or method for attaching molecular moieties to a particular device must involve numerous common features as dictated by the device itself. Given the substantial overlap between the subject matter of the claims of Groups III and IV, then, it would not pose a serious burden on the part of the Examiner to search and examine these claims together. Accordingly, Applicants respectfully traverse this restriction and request that these claims be searched and examined together.

CLAIMS SETTING FORTH THE ASSAYING OF A SAMPLE USING A DEVICE COMPRISING A SUBSTRATE AND AN INTEGRATED INDICATOR

The Examiner further states that Groups V and VI are related as a process and an apparatus for carrying out the process. In support, the Examiner asserts that the apparatus as claimed can be used to practice another different process. As examples, the Examiner contends that the apparatus may be used to carry out oligonucleotide synthesis or to prepare a coated substrate.

Although Applicants recognize that the claims directed to a process and apparatus for its practice are typically distinct, it should be noted that all of the claims of Groups V and VI recite the application of a sample so that the sample contacts the molecular probes attached to the substrate surface of the device of claim 1. Thus, these claims also involve common features as dictated by the device of claim 1. Accordingly, Applicants requests that these claims be searched and examined together as well.

CONCLUSION

As set forth above, Applicants elect the claims of Group I and traverse the restriction between the claims of Groups I and II, between the claims of Groups III and IV, and between the claims of Groups V and VI. Based upon the foregoing arguments, Applicants respectfully request that claims 1-58 remain together in a first group, claims 59-62 remain together in a second group and claims 63-80 remain together in a third group. Should the Examiner grant this request, Applicants elect to pursue device claims 1-58 in this application and reserve the right to file divisional applications during the pendency of this application on the remaining unelected claims. In addition, Applicants have elected the species (1) as indicated on page 2 of this Response, without traverse.

The Examiner is welcome to contact the undersigned attorney at (650) 330-0900 with any questions relating to this Response or to the subject application.

Respectfully submitted,

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